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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,989	09/11/2003	Oded E. Sturman	2590P069	4652

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER	
FETSUGA, ROBERT M	
ART UNIT	**PAPER NUMBER**
3751	

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/659,989	STURMAN, ODED E.	
	Examiner	Art Unit	
	Robert M. Fetsuga	3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08/16/05, 10/26/05 & 01/09/06*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-8,10-26 and 28-41* is/are pending in the application.

4a) Of the above claim(s) *3-7,12-25,28-30 and 33-41* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 8, 10, 11, 26, 31 and 32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *09/21/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Claims 2-7, 14-25, 28, 29 and 33-40 were previously withdrawn from further consideration based upon applicants' affirmative elections made January 07, 2005 (pg. 1) and June 03, 2005 (pg. 9). Claims 12, 13 and 30 were also withdrawn from further consideration based upon the facts presented by the examiner in the Office action mailed July 07, 2005 (par. 1).

Re claims 3, 4 and 7, applicant argues at page 12 of the response filed October 26, 2005 these claims "read on the elected invention". However, absent any showing as to why this statement should be accepted over applicants' original statement noted supra, the claims will remain withdrawn.

Re claim 12, applicant argues at page 12 of the response filed August 16, 2005 (repeated in the response filed October 26, 2005) the sentence at page 17, line 9 of the instant specification indicates the substance of claim 12 encompasses the elected embodiment. The examiner has again reviewed page 17, but no mention of a "zero nonmagnetic gap" is found therein as it is found at page 9, line 19. Furthermore, applicant argues at page 12 of the response filed October 26, 2005 claims 12, 13 and 41 "read on the elected invention". However, this statement adds nothing to the argument found in the August 16, 2005 response.

Accordingly, claims 3-7, 12-25, 28-30 and 33-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b).

2. The disclosure is objected to because of the following informalities: In the paragraph beginning on line 12 of page 15, line 8, "52" apparently should be --48--, and line 12, "50" apparently should be --56--; and in the paragraph beginning on line 21 of page 16, lines 11 and 16, "72" designates different elements.

Appropriate correction is required.

3. Claims 8, 10, 11, 26, 31 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites "the first magnetic member being electromagnetically attracted to the second position by electrical excitation of the second electromagnetic coil". This is not possible in light of applicant's disclosure. The first coil must be the right coil, and the second position must be the right position (actuated), in the Fig. 4 embodiment as reflected in parent claim 1. Therefore, the metes and bounds of the language of claim 8 is not ascertainable. Claims 10 and 11 depend from, but do not clarify, the substance of claim 8.

Claim 26 is ambiguous as attempting to embrace two different statutory classes of invention. The claim preamble recites a "method", but the body thereof merely recites product/apparatus limitations. See IPXL Holdings LLC v. Amazon.com Inc. 77 USPQ2d 1140. Claims 31 and 32 depend from, but do not clarify, the substance of claim 26.

Claim 26 recites "compressing a first preloaded spring only as the first magnetic member moves". This language is prima facie indefinite as a "preloaded" spring is always "compressed" to some degree. Claims 31 and 32 depend from, but do not clarify, the substance of claim 26.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Kolchinsky et al.

The Kolchinsky et al. (Kolchinsky) reference discloses an actuator comprising: first 15 and second 32 magnetic members; an electromagnetic coil 20; a first preloaded spring 35; and a second preloaded spring 35, as claimed.

Applicant argues at page 12 of the response filed August 16, 2005 (repeated in the response filed October 26, 2005) the springs in the Kolchinsky actuator are "active only over one half of the travel of the moveable member". The examiner can not agree, and notes Kolchinsky expressly teaches that such a statement is inaccurate. See lines 32-37 in column 4 of Kolchinsky.

6. Applicant's remaining remarks have been fully considered and either have been previously addressed or are not deemed persuasive in view of the prior art as specifically applied in light of the level of skill in the pertinent art.

7. The grounds of rejection have been reconsidered in light of applicant's arguments, but are still deemed to be proper.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated

from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication should be directed to Robert M. Fetsuga at telephone number 571/272-4886 who can be most easily reached Monday through Thursday. The Office central fax number is 571/273-8300.

Robert M. Fetsuga
Primary Examiner
Art Unit 3751